

REMARKS/ARGUMENTS

Claims 1-12, 14-36 and 38-60 are pending. Claims 1-12, 14-36 and 38-60 were rejected.

35 U.S.C. § 102 Rejections

Claim 1 was rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,185,306 to Mages et al. (hereinafter “*Mages*”). As the Office Action states, both *Mages* and Claim 1 share the same general concept, namely, each “disclose[s] a method for playing files from two portions, each of which is unusable as a media file and each of which is delivered via a separate channel....” However, while the Office Action is correct that Claim 1 and *Mages* share a general concept, Claim 1 discloses an embodiment of that concept that is not disclosed (or even suggested) by *Mages*.

Specifically, *Mages* discloses a system in which an address or URL is stored along with the first portion of the media file so that the system can locate the server from which the second portion of a media file may be retrieved. For example, *Mages* discloses that a first (crippled) portion of a media file may be contained on a CD-ROM and further that “the CD-ROM contains a code representing the URL web page of the host computer where the necessary de-crippling key is located.” Col. 6 lines 57-60. *See also* Fig. 5 block 16 (“HyperCD is encoded with crippled data and unique URL’s [sic] to locate source data on HyperCD and client’s web pages on host server.”). Thus, as disclosed by *Mages*, the second (de-crippling) portion can be located and retrieved by referencing the content of the first portion of the media file. Furthermore, because the address of the second portion is stored with the content of the first portion, anyone who gained access to the first portion of a media file would then know where to seek the second portion.

The invention claimed in Claim 1, by contrast, does not store the location or address of one or more second portions of the media file along with the content of the first portion. Therefore, the second portions must be retrieved without referring to the content of the first portion of the media file. For example, Claim 1 reads as follows:

A method of creating a media file for playing in an electronic device, comprising:
receiving a first file portion of the media file with the electronic device from a first computing device via a first communication channel as a result of commands initiated from a media client of the electronic device, wherein the first file portion is unusable as a media file;

receiving a plurality of second file portions of the media file with the electronic device from a second computing device via a second communication channel as a result of commands initiated from the media client, wherein the plurality of second file portions are unusable as a media file and **the media client initiates commands resulting in said receiving of the second file portion without reference to the content of the first file portion to identify the second computing device;** and creating with the media client the media file in the electronic device from the first file portion and at least one of the plurality of second file portions.

(emphasis added). As a result, one who gains access to the first portion of a media file cannot determine where to seek the second portions. *Mages* does not anticipate Claim 1 because *Mages* does not disclose that the second portions of media files must be retrieved without referring to the content of the first portion of the media file.

In addition, *Mages* does not disclose “receiving a **plurality** of second file portions,” as claimed in Claim 1. On the contrary, *Mages* consistently and repeatedly refers to crippled media that may be accessed upon the receipt of only one single “uncrippling or triggering key.” *E.g.* *Mages* Col. 6 lines 5, 16, 20, 59; Col. 7 line 28. Nowhere does *Mages* disclose or even hint that media may only be de-crippled after the receipt of a **plurality** of second file portions or keys. Applicants therefore further respectfully submit that *Mages* does not anticipate Claim 1.

Finally, *Mages* does not disclose that the second portions are received “as a result of commands initiated from the media client,” as claimed in Claim 1. On the contrary, *Mages* specifically teaches that a media client must launch the user’s web browser in order to retrieve the de-crippling key. Col. 6 lines 64-67 (data on the CD-ROM “will automatically find the end-user’s browser, will call the Internet service provider, pass the necessary links from the CD-ROM to the browser in order to get to the host’s web page”). Thus, *Mages* does not disclose that the second portions are received “as a result of commands initiated from the media client,” as claimed in Claim 1.

As described above, Claim 1 recites limitations that are patentably distinct from what is disclosed in *Mages*. Accordingly, Applicants respectfully submit that *Mages* does not anticipate Claim 1. Independent Claims 9, 15, 26, 32, 39, 51, and 53 are also allowable through similar reasoning.

35 U.S.C. § 103 Rejections

Claims 2-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mages* in view of U.S. Patent No. 6,373,831 to Secord et al. (hereinafter “*Secord*”). However, as discussed above *Mages* does not anticipate independent Claim 1. Therefore, Claims 2-8 are allowable at least by dependency because *Secord* does not, by way of disclosure or suggestion, remedy the deficiencies in *Mages* that are discussed above. On the contrary, *Secord* describes merely a Code Division Multiple Access transmission system, such as is commonly used with cell phones.

Applicants therefore respectfully submit that Claims 2-8 are also allowable because an ordinarily skilled practitioner would have had no motivation whatsoever to modify the teachings of *Mages* with those of *Secord*. Asserting to the contrary, the Office Action states that such a one would have been motivated “because employing portable computing devices are conventional functional equivalents of the claim limitations in order to practice the disclosure of the prior art.” Applicants have had some difficulty parsing this statement and request a clarification of the asserted motivation.

That said, Applicants respectfully submit that there can be no motivation to combine *Mages* with *Secord* because the two reside in completely unrelated fields and that any motivation to combine them can be found only by using the present claims as blueprints to assemble otherwise unrelated elements using hindsight analysis, an analysis that is expressly forbidden:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention “as a whole.” Inventions typically are new combinations of existing principles or features. The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result—often the very definition of invention.

Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275 (Fed. Cir. 2004) (internal citations omitted); see also, e.g., *Texas Instruments Inc. v. U.S. Intern. Trade Com'n*, 988 F.2d 1165, 1178 (Fed. Cir. 1993) (holding that it is impermissible to “piece the invention together using the

patented invention as a template” when the “references in combination do not suggest the invention as a whole”); *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements”).

Recent U.S. Supreme Court jurisprudence supports this conclusion. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.”). In that case, the Supreme Court explained that when conducting a § 103 obviousness analysis, it is generally “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* The proper question to ask is whether a “designer of ordinary skill, facing the wide range of needs created by developments in the field of endeavor, would have seen a benefit to upgrading” a piece of prior art in a manner that leads to the claimed invention. *See id.* at 1744. In *KSR*, the proper inquiry was whether such a designer would have seen a benefit to upgrading one reference by adding a modular sensor, such as was described in another reference, and such as was claimed in the claim at issue. *Id.*

Following this reasoning, the proper inquiry regarding Claims 2-8 is whether an ordinarily skilled designer would have seen a benefit to upgrading *Mages* with *Secord* in a manner as is described in Claims 2-8. Applicants respectfully submit that an ordinarily skilled designer would have seen no such benefit for the following reasons.

Mages deals exclusively with enabling crippled content on CD-ROMs whereas *Secord* deals exclusively with a specific method of multicast data transmission. Moreover, there is no hint or suggestion in *Mages* that its CD-ROM content protection system would benefit from the addition of any specific method of multicast data transmission, such as is disclosed in *Secord*. In fact, *Mages* is entirely unconcerned about the specific method of data transmission that it uses to retrieve de-crippling keys, and it is improper to try and shoehorn into *Mages* the unrelated teachings of *Secord* merely because such shoehorning is necessary to assemble all of the elements that are claimed in Claims 2-8. Only by using impermissible hindsight analysis can be found any motivation to combine *Mages* with *Secord*.

Similarly, there is absolutely no suggestion in *Secord* that its teachings have any relation whatsoever to de-crippling content stored in CD-ROMs, such as is disclosed in *Mages*. *Secord* deals exclusively with a particular method of data transmission, with

absolutely no regard for the type of data that is transmitted or the type of device that sends or receives the transmissions. There is no hint or suggestion in *Secord* that its transmission system would benefit from a CD-ROM content protection system, such as is claimed in *Mages*.

Thus, the only motivation to combine *Secord* with *Mages* is derived from the fact that the inventions claimed in Claims 2-8 suggest in hindsight that elements of *Secord* could be used with a device that implements a conceptually similar scheme to that disclosed in *Mages*. Accordingly, the Office Action erred in asserting that an ordinarily skilled practitioner would have had any motivation to combine *Secord* with *Mages*.

Applicants respectfully assert that all remaining claims are patentably distinguishable from the cited documents on at least the same and/or a similar basis as Claims 1-8. Therefore, it is respectfully requested that the Examiner withdraw these rejection and allow the pending claims to proceed to issuance.

For at least the reasons above, Assignee respectfully submits that claims 1-12, 14-36, and 38-60 are allowable and requests that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, the foregoing is believed sufficient to address the Examiner's rejections. Likewise, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Applicants do not agree.

CONCLUSION

Applicants respectfully submit that all pending claims are in condition for allowance. Accordingly, early and favorable action allowing all of the pending claims and passing this Application to issue is respectfully requested. The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this Application.

We believe the appropriate fees accompany this transmission. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to AXIOS Law Group's deposit account. The deposit account number is 50-4051.

Respectfully submitted,
AXIOS LAW GROUP

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by: /Adam L.K. Philipp/
Adam L.K. Philipp
Reg. No.: 42,071
Direct Dial: 206.217.2226

AXIOS Law Group
1525 Fourth Avenue, Suite 800
Seattle, WA 98101
Telephone: 206.217.2200
Customer No.: 61857